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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL FAX CENTER

In re application of: Gupta

Serial No.: 09/881,872

Filed: June 14, 2001

For: Apparatus and Method for
Selecting Closing Information and
Stationery for an Electronic Mail
Message Based on the Intended
Recipient

35525

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER§
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Group Art Unit: 2152

Examiner: Refal, Ramsey

Attorney Docket No.: AUS920010383US1

NOV 14 2005

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- Appeal Brief (37 C.F.R. 41.37)

A fee of \$500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0447. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,


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RECEIVED
CENTRAL FAX CENTER

NOV 14 2005 **PATENT**

Docket No. AUS920010383US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gupta

Serial No.: 09/881,872

Filed: June 14, 2001

**For: Apparatus and Method for
Selecting Closing Information and
Stationery for an Electronic Mail
Message Based on the Intended
Recipient**

1. 2. 3. 4. 5. 6. 7. 8. 9. 10. 11. 12. 13. 14. 15. 16. 17. 18. 19. 20. 21. 22. 23. 24. 25. 26. 27. 28. 29. 30. 31. 32. 33. 34. 35. 36. 37. 38. 39. 40. 41. 42. 43. 44. 45. 46. 47. 48. 49. 50. 51. 52. 53. 54. 55. 56. 57. 58. 59. 60. 61. 62. 63. 64. 65. 66. 67. 68. 69. 70. 71. 72. 73. 74. 75. 76. 77. 78. 79. 80. 81. 82. 83. 84. 85. 86. 87. 88. 89. 90. 91. 92. 93. 94. 95. 96. 97. 98. 99. 100. 101. 102. 103. 104. 105. 106. 107. 108. 109. 110. 111. 112. 113. 114. 115. 116. 117. 118. 119. 120. 121. 122. 123. 124. 125. 126. 127. 128. 129. 130. 131. 132. 133. 134. 135. 136. 137. 138. 139. 140. 141. 142. 143. 144. 145. 146. 147. 148. 149. 150. 151. 152. 153. 154. 155. 156. 157. 158. 159. 160. 161. 162. 163. 164. 165. 166. 167. 168. 169. 170. 171. 172. 173. 174. 175. 176. 177. 178. 179. 180. 181. 182. 183. 184. 185. 186. 187. 188. 189. 190. 191. 192. 193. 194. 195. 196. 197. 198. 199. 200. 201. 202. 203. 204. 205. 206. 207. 208. 209. 210. 211. 212. 213. 214. 215. 216. 217. 218. 219. 220. 221. 222. 223. 224. 225. 226. 227. 228. 229. 230. 231. 232. 233. 234. 235. 236. 237. 238. 239. 240. 241. 242. 243. 244. 245. 246. 247. 248. 249. 250. 251. 252. 253. 254. 255. 256. 257. 258. 259. 260. 261. 262. 263. 264. 265. 266. 267. 268. 269. 270. 271. 272. 273. 274. 275. 276. 277. 278. 279. 280. 281. 282. 283. 284. 285. 286. 287. 288. 289. 290. 291. 292. 293. 294. 295. 296. 297. 298. 299. 300. 301. 302. 303. 304. 305. 306. 307. 308. 309. 310. 311. 312. 313. 314. 315. 316. 317. 318. 319. 320. 321. 322. 323. 324. 325. 326. 327. 328. 329. 330. 331. 332. 333. 334. 335. 336. 337. 338. 339. 340. 341. 342. 343. 344. 345. 346. 347. 348. 349. 350. 351. 352. 353. 354. 355. 356. 357. 358. 359. 360. 361. 362. 363. 364. 365. 366. 367. 368. 369. 370. 371. 372. 373. 374. 375. 376. 377. 378. 379. 380. 381. 382. 383. 384. 385. 386. 387. 388. 389. 390. 391. 392. 393. 394. 395. 396. 397. 398. 399. 400. 401. 402. 403. 404. 405. 406. 407. 408. 409. 410. 411. 412. 413. 414. 415. 416. 417. 418. 419. 420. 421. 422. 423. 424. 425. 426. 427. 428. 429. 430. 431. 432. 433. 434. 435. 436. 437. 438. 439. 440. 441. 442. 443. 444. 445. 446. 447. 448. 449. 450. 451. 452. 453. 454. 455. 456. 457. 458. 459. 460. 461. 462. 463. 464. 465. 466. 467. 468. 469. 470. 471. 472. 473. 474. 475. 476. 477. 478. 479. 480. 481. 482. 483. 484. 485. 486. 487. 488. 489. 490. 491. 492. 493. 494. 495. 496. 497. 498. 499. 500. 501. 502. 503. 504. 505. 506. 507. 508. 509. 510. 511. 512. 513. 514. 515. 516. 517. 518. 519. 520. 521. 522. 523. 524. 525. 526. 527. 528. 529. 530. 531. 532. 533. 534. 535. 536. 537. 538. 539. 540. 541. 542. 543. 544. 545. 546. 547. 548. 549. 550. 551. 552. 553. 554. 555. 556. 557. 558. 559. 560. 561. 562. 563. 564. 565. 566. 567. 568. 569. 570. 571. 572. 573. 574. 575. 576. 577. 578. 579. 580. 581. 582. 583. 584. 585. 586. 587. 588. 589. 590. 591. 592. 593. 594. 595. 596. 597. 598. 599. 600. 601. 602. 603. 604. 605. 606. 607. 608. 609. 610. 611. 612. 613. 614. 615. 616. 617. 618. 619. 620. 621. 622. 623. 624. 625. 626. 627. 628. 629. 630. 631. 632. 633. 634. 635. 636. 637. 638. 639. 640. 641. 642. 643. 644. 645. 646. 647. 648. 649. 650. 651. 652. 653. 654. 655. 656. 657. 658. 659. 660. 661. 662. 663. 664. 665. 666. 667. 668. 669. 670. 671. 672. 673. 674. 675. 676. 677. 678. 679. 680. 681. 682. 683. 684. 685. 686. 687. 688. 689. 690. 691. 692. 693. 694. 695. 696. 697. 698. 699. 700. 701. 702. 703. 704. 705. 706. 707. 708. 709. 710. 711. 712. 713. 714. 715. 716. 717. 718. 719. 720. 721. 722. 723. 724. 725. 726. 727. 728. 729. 730. 731. 732. 733. 734. 735. 736. 737. 738. 739. 740. 741. 742. 743. 744. 745. 746. 747. 748. 749. 750. 751. 752. 753. 754. 755. 756. 757. 758. 759. 760. 761. 762. 763. 764. 765. 766. 767. 768. 769. 770. 771. 772. 773. 774. 775. 776. 777. 778. 779. 780. 781. 782. 783. 784. 785. 786. 787. 788. 789. 790. 791. 792. 793. 794. 795. 796. 797. 798. 799. 800. 801. 802. 803. 804. 805. 806. 807. 808. 809. 810. 811. 812. 813. 814. 815. 816. 817. 818. 819. 820. 821. 822. 823. 824. 825. 826. 827. 828. 829. 830. 831. 832. 833. 834. 835. 836. 837. 838. 839. 840.

Group Art Unit: 2152

Examiner: Refai, Ramsey

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By:

Amelia C. Turner
Amelia C. Turner

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on September 13, 2005.

The fees required under § 41.20(B)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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(Appeal Brief Page 1 of 30)
Gupta - 09/881,872

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-41

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: NONE
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-41
4. Claims allowed: NONE
5. Claims rejected: 1-41
6. Claims objected to: NONE

C. CLAIMS ON APPEAL

The claims on appeal are: 1-41

STATUS OF AMENDMENTS

There are no amendments after final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER***Independent claim 1:***

The presently claimed invention provides a method for formatting an electronic mail message. The present invention retrieves one or more recipient profiles from storage. Each recipient profile identifies an electronic mail message format for a corresponding recipient. See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16. The present invention identifies a recipient of an electronic mail message and formats content of the electronic mail message based on a recipient profile corresponding to the identified recipient. See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18.

Independent claim 11:

The presently claimed invention provides a method for customizing an electronic mail message based on settings for a recipient. The present invention receives an electronic mail message. See specification, page 12, lines 23-27; page 13, line 29, to page 14, line 8; page 18, lines 15-22. The present invention retrieves one or more recipient profiles from storage. Each recipient profile identifies an electronic mail message format for a corresponding recipient. See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16. The present invention identifies at least one recipient of an electronic mail message. The present invention identifies at least one electronic mail message format from the one or more profiles for the at least one recipient. The present invention then reformats content of the electronic mail message based on the at least one electronic mail message format. See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18.

Independent claim 21:

The presently claimed invention provides a method for customizing an electronic mail message based on settings for an intended recipient. The present invention stores electronic mail format settings in recipient profiles for a plurality of possible recipients. The electronic mail format settings designate an electronic mail format for a recipient that is different from an electronic mail format of another recipient. See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16. An electronic mail message is generated for at least one designated recipient of the plurality of possible recipients. See specification, page 12, lines 23-27; page 13, line 29, to page 14, line 8; page 18, lines 15-22. The present invention customizes content of the electronic mail message according to the electronic mail format settings for the recipient. See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18.

Independent claims 22:

The presently claimed invention provides an apparatus for customizing an electronic mail message based on settings for a recipient. The present invention comprises an interface 420 that receives an electronic mail message. See specification, page 12, lines 23-27; page 13, line 29, to page 14, line 8; page 18, lines 15-22. The present invention comprises an electronic mail message formatting device 450 that retrieves one or more recipient profiles from storage. Each recipient profile identifies an electronic mail message format for a corresponding recipient. See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16. The electronic mail message formatting device 450 identifies at least one recipient of an electronic mail message. The present invention identifies at least one electronic mail message format from the one or more profiles for the at least one recipient. The present invention then reformats content of the electronic mail message based on the at least one electronic mail message format. See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18.

Independent claim 32:

The presently claimed invention provides a computer program product for customizing an electronic mail message based on settings for a recipient. The present invention receives an electronic mail message. See specification, page 12, lines 23-27; page 13, line 29, to page 14, line 8; page 18, lines 15-22. The present invention retrieves one or more recipient profiles from storage. Each recipient profile identifies an electronic mail message format for a corresponding recipient. See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16. The present invention identifies at least one recipient of an electronic mail message. The present invention identifies at least one electronic mail message format from the one or more profiles for the at least one recipient. The present invention then reformats content of the electronic mail message based on the at least one electronic mail message format. See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18. The computer instructions embodied on a computer readable medium are as described with reference to Figure 10 in the description at page 22, line 3, to page 23, line 31.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection on appeal are as follows:

- I. Claims 1, 4-9, 11, 16-19, 21, 22, 25-30, 32, and 35-40 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Gilbert* (U.S. Patent No. 6,529,942);
- II. Claims 2, 3, 10, 12-15, 20, 23, 24, 31, 33, 34, and 41 are rejected under 35 U.S.C. § 103(a) as being allegedly obvious over *Gilbert* (U.S. Patent No. 6,529,942) in view of *Scheutze et al.* (U.S. Patent No. 6,101,320).

ARGUMENT

I. 35 U.S.C. § 102, Alleged Anticipation of claims 1, 4-9, 11, 16-19, 21, 22, 25-30, 32, and 35-40

The Office Action rejects claims 1, 4-9, 11, 16-19, 21, 22, 25-30, 32, and 35-40 under 35 U.S.C. § 102(e) as being allegedly anticipated by *Gilbert* (U.S. Patent No. 6,529,942). This rejection is respectfully traversed.

IA. 35 U.S.C. § 102, Alleged Anticipation of claims 1, 4-9, 11, 16-19, 22, 25-30, 32, and 35-40

Gilbert teaches a system and method for providing recipient specific formats for electronic mail. A composer of an email message may customize the format of text within the email message by embedding codes within the message. The cited portion of *Gilbert* states:

The present invention is embodied in a functional component that recognizes embedded processing codes for a specific recipient in an e-mail system. This functional component can be integrated into e-mail software or can exist separate from the electronic mail software. Upon recognition of an embedded text format command, the functional component changes the font characteristics of selected text for specific recipients based upon an identifier code identifying each recipient's message. Individualized copies of the original message are automatically created for each recipient. The invention thus allows a single message to be modified for more than one recipient such that individual modifications corresponding to a particular recipient are received only by that recipient. A computerized network serving as an environment for the present invention is first described. Next, the processing steps required to format text for a specific recipient are described along with the processing steps necessary for automatically creating e-mail messages. Examples of e-mail messages with embedded processing codes are also presented.

Gilbert, col. 3, lines 3-22. Thus, *Gilbert* teaches that when a composer of an electronic mail wishes to customize the format for an email message, the composer must deliberately embed specific commands within the message for each intended recipient. Customized format is only effectuated through these embedded commands.

In contradistinction, the present invention allows customization of an electronic mail message based on one or more recipient profiles. Claim 1 recites:

1. A method of formatting an electronic mail message, comprising:
retrieving one or more recipient profiles from storage, wherein the one or more recipient profiles identify an electronic mail message format for a corresponding recipient;
identifying a recipient of an electronic mail message; and
formatting content of the electronic mail message based on a recipient profile corresponding to the identified recipient.

Gilbert does not teach or suggest at least retrieving one or more recipient profiles from storage, as recited in claim 1, for example. The Office Action alleges that *Gilbert* teaches this feature at col. 5, lines 47-55; col. 9, lines 6-11, because the mail server of *Gilbert* reformats the content of the message by referring to profiles stored on the mail server that matches the recipient's user name to the identifier code, which represents the format specific to that corresponding user.

The cited portions of *Gilbert* teach as follows:

As will be readily recognized by one skilled in the art, a variety of embodiments for automatically creating individualized e-mail messages are possible. In one embodiment, the software is installed in the originating user's data processing system 20 which analyzes or parses the message and generates a separate, properly formatted e-mail message for each recipient. In another embodiment, a computer coupled to the network 10 as a mail server 11 contains the software which processes the original e-mail message having the embedded processing codes.

Gilbert, col. 5, lines 46-55.

One embodiment is to have the originating user's software analyze or parse the message and generate separate, properly formatted e-mail messages for each recipient. Another embodiment is to have a mail server 11 or an equivalent network device process the e-mail message when sending the message to the correct recipients. A third embodiment of processing inserted format commands and automatically creating individualized messages involves performing these tasks on the recipient's data processing machine 20. In this embodiment, each recipient receives all the inserted format commands that were encoded but their data processing system 20 only decodes the inserted format commands relevant to them.

Gilbert, col. 9, lines 6-17. Clearly, the cited portion does not teach retrieving recipient profiles from storage, because *Gilbert* specifically teaches parsing electronic mail messages to find embedded processing codes or inserted format commands. In fact, the word "profile" does not appear anywhere within the *Gilbert* disclosure.

Gilbert appears to solve a similar problem as the present invention; however, *Gilbert* solves the problem in a very different manner. That is, *Gilbert* solves the problem of customizing the content of email messages by embedding recipient-specific formatting commands within the document itself. *Gilbert* does not teach or suggest retrieving one or more recipient profiles and formatting content of the electronic message based on a recipient profile corresponding to the intended recipient, as recited in claim 1, for example.

The applied reference does not teach or suggest each and every claim limitation; therefore, *Gilbert* does not anticipate claim 1. Independent claims 11, 22, and 32 recite subject matter addressed above with respect to claim 1 and are allowable for similar reasons. Since claims 4-9, 16-19, 25-30, and 35-40 depend from claims 1, 11, 22, and 32, the same distinctions between *Gilbert* and the invention recited in claims 1, 11, 22, and 32 apply for these claims. Additionally, claims 4-9, 16-19, 25-30, and 35-40 recite other additional combinations of features not suggested by the reference.

Therefore, Appellant respectfully requests that the rejection of claims 1, 4-9, 11, 16-19, 22, 25-30, 32, and 35-40 under 35 U.S.C. § 102(e) not be sustained.

Furthermore, *Gilbert* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Gilbert* actually teaches away from the presently claimed invention because it teaches embedding recipient-specific formatting commands into an email message, as opposed to using one or more recipient profiles that identify an electronic mail message format for a corresponding recipient, as in the presently claimed invention. Absent the Office Action pointing out some teaching or incentive to implement *Gilbert* to use recipient profiles to format the content of electronic mail messages, one of ordinary skill in the art would not be led to modify *Gilbert* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Gilbert* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Appellant's disclosure as a template to make the necessary changes to reach the claimed invention.

IA1. 35 U.S.C. § 102. Alleged Anticipation of claims 4, 14, 25, and 35

With respect to claims 4, 14, 25, and 35, *Gilbert* fails to teach or suggest identifying a set of compatible electronic mail format settings from among electronic mail format settings defined

in recipient profiles of a plurality of designated recipients. The Office Action alleges that *Gilbert* teaches this limitation in col. 4, lines 16-30, which states as follows:

The present invention recognizes processing codes embedded within an e-mail message so that selected text within the message can be changed for specific recipients based upon an identifier code corresponding to each recipient's message. Furthermore, the present invention automatically creates an e-mail message corresponding to each specific recipient after the embedded processing codes have been correlated to each recipient. The functions of the present invention can be implemented within an e-mail system or can be provided as an add-on component to the e-mail system. The present invention is not limited to any particular e-mail system and one skilled in the art will recognize that the teaching of the present invention can be implemented in a variety of e-mail systems.

The cited portion of *Gilbert* merely teaches automatically creating an electronic mail message corresponding to each specific recipient after embedded processing codes have been correlated to each recipient. The cited portion makes no mention of identifying compatible electronic mail settings from among the electronic mail format settings of a plurality of designated recipients, as recited in claims 4, 14, 25, and 35. The Office Action proffers no analysis as to why the cited portion somehow teaches the limitations of claims 4, 14, 25, and 35; therefore, the Office Action does not establish a *prima facie* case of anticipation for these claims.

Therefore, Appellant respectfully requests that the rejection of claims 4, 14, 25, and 35 under 35 U.S.C. § 102(e) not be sustained.

IA1(a). 35 U.S.C. § 102, Alleged Anticipation of claim 6

With respect to claim 6, *Gilbert* fails to teach or suggest wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check. *Gilbert* teaches that recipient-specific formatting commands may be embedded within a message in association with particular text. Thus, these formatting commands may include text size, color, bold, italic, superscript, subscript, etc. However, *Gilbert* does not teach or suggest electronic mail message format settings that include closing information, stationery, or whether to use spell check, as recited in claims 6, 16, 27, and 37.

The Office Action alleges that *Gilbert* teaches spell checking. While *Gilbert* does nominally mention spell check as an option in a content-sensitive menu, *Gilbert* does not teach or

suggest that whether to use spell check being defined in electronic mail format settings, as recited in claims 6, 16, 27, and 37. The Office Action proffers no analysis as to why conventional spell check is somehow equivalent to the specific limitation of identifying a set of compatible electronic mail format settings from among electronic mail format settings defined in recipient profiles of a plurality of designated recipients, wherein the electronic mail format settings include whether to use spell check.

Therefore, Appellant respectfully requests that the rejection of claim 6 under 35 U.S.C. § 102(e) not be sustained.

IA2. 35 U.S.C. § 102, Alleged Anticipation of claims 16, 27, and 37

With respect to claims 16, 27, and 37, *Gilbert* fails to teach or suggest wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check. *Gilbert* teaches that recipient-specific formatting commands may be embedded within a message in association with particular text. Thus, these formatting commands may include text size, color, bold, italic, superscript, subscript, etc. However, *Gilbert* does not teach or suggest electronic mail message format settings that include closing information, stationery, or whether to use spell check, as recited in claims 16, 27, and 37.

The Office Action alleges that *Gilbert* teaches spell checking. While *Gilbert* does nominally mention spell check as an option in a content-sensitive menu, *Gilbert* does not teach or suggest that whether to use spell check being defined in electronic mail format settings, as recited in claims 16, 27, and 37. The Office Action proffers no analysis as to why conventional spell check is somehow equivalent to the specific limitation of electronic mail format settings from a recipient profile including whether to use spell check.

Therefore, Appellant respectfully requests that the rejection of claims 16, 27, and 37 under 35 U.S.C. § 102(e) not be sustained.

IB. 35 U.S.C. § 102, Alleged Anticipation of claim 21

With reference to claim 21, *Gilbert* fails to teach or suggest storing electronic mail settings in recipient profiles for a plurality of possible recipients. Claim 21 recites:

21. A method of customizing an electronic mail message based on settings for an intended recipient, comprising:

storing electronic mail format settings in recipient profiles for a plurality of possible recipients, the electronic mail format settings designating an electronic mail format for a recipient that is different from an electronic mail format of another recipient;

generating an electronic mail message for at least one designated recipient of the plurality of possible recipients; and

customizing content of the electronic mail message according to the electronic mail format settings for the recipient.

As explained above, *Gilbert* appears to solve a similar problem as the present invention; however, *Gilbert* solves the problem in a very different manner. That is, *Gilbert* solves the problem of customizing the content of email messages by embedding recipient-specific formatting commands within the document itself. *Gilbert* does not teach or suggest storing electronic mail format settings in recipient profiles for a plurality of possible recipients, the electronic mail format settings designating an electronic mail format for a recipient that is different from an electronic mail format of another recipient, as recited in claim 21, for example.

The applied reference does not teach or suggest each and every claim limitation; therefore, *Gilbert* does not anticipate claim 21. Appellant respectfully requests that the rejection of claim 21 under 35 U.S.C. § 102(e) not be sustained.

II. 35 U.S.C. § 103, Alleged Obviousness of claims 2, 3, 10, 12-15, 20, 23, 24, 31, 33, 34, and 41

The Office Action rejects claims 2, 3, 10, 12-14, 20, 23-24, 31, 33-34, and 41 under 35 U.S.C. § 103(a) as being unpatentable over *Gilbert* in view of *Schuetze et al.* (U.S. Patent No. 6,101,320). This rejection is respectfully traversed.

Claims 2, 3, 10, 12-15, 20, 23, 24, 31, 33, 34 and 41 depend from claims 1, 11, 22, and 32 and are allowable for at least the reasons stated above with respect to claims 1, 11, 22, and 32. More particularly, *Gilbert* teaches providing recipient specific formats by embedding recipient-specific formatting commands within the message. *Gilbert* does not teach or suggest retrieving one or more recipient profiles and formatting content of the electronic message based on a recipient profile corresponding to the intended recipient. *Schuetze* does not make up for the deficiencies of *Gilbert*.

Schuetze teaches an electronic mail communication system and method for exchanging electronic mail messages between organizations having dissimilar electronic mail systems. In

Schuetze, when an electronic mail message is received at a router, the router identifies the recipient organization and changes the transmission format of the message to match the recipient's electronic mail system. However, *Schuetze* does not teach or suggest formatting the content of an electronic mail message. Rather, *Schuetze* is concerned with the transmission format expected by the recipient's electronic mail system.

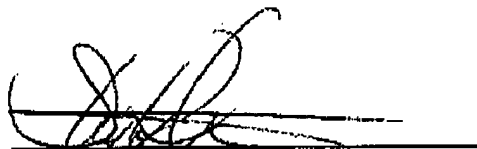
Even if *Gilbert* and *Schuetze* could be properly combined, the proposed combination would not form the presently claimed invention. Instead, a combination of *Gilbert* and *Schuetze* would result in a composer using embedded commands to customize content for specific recipients and a router changing the transmission format to the format expected by the recipient's electronic mail system. *Gilbert* and *Schuetze* solve different problems and can be used together without modifying the teachings of either reference. That is, if one were to customize the content of an electronic message given only the teachings of the applied reference, one would look only to the teachings of *Gilbert* to solve the problem. On the other hand, if one were to implement a router that had the capability of customizing the transmission format of an electronic mail message, one would look only to the teachings of *Schuetze*. Thus, there is no reason to combine *Gilbert* and *Schuetze* based on the teachings of the two disparate references.

Therefore, *Gilbert* and *Schuetze*, taken individually or in combination, fail to teach or suggest the invention recited in at least claims 1, 11, 22, and 32. The proposed combination of *Gilbert* and *Schuetze* is insufficient to render claims 1, 11, 22, and 32 obvious. It follows that the proposed combination also fails to render dependent claims 2, 3, 10, 12-15, 20, 23, 24, 31, 33, 34 and 41 by virtue of their dependency.

Therefore, Appellant respectfully requests that the rejection of claims 2-3, 10, 12-14, 20, 23-24, 31, 33-34, and 41 under 35 U.S.C. § 103(a) not be sustained.

CONCLUSION

In view of the above, Appellant respectfully submits that claims 1-41 are allowable over the cited prior art and that the application is in condition for allowance. Accordingly, Appellant respectfully requests the Board of Patent Appeals and Interferences to not sustain the rejections set forth in the Final Office Action.



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CLAIMS APPENDIX

The text of the claims involved in the appeal reads:

1. A method of formatting an electronic mail message, comprising:
retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient;
identifying a recipient of an electronic mail message; and
formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient.
2. The method of claim 1, wherein the one or more recipient profiles include a recipient group format setting corresponding to a plurality of recipients, and wherein the recipient group format setting identifies electronic mail format settings that are common to the plurality of recipients.
3. The method of claim 1, wherein the one or more recipient profiles include a domain name category format setting corresponding to a plurality of recipients, and wherein the domain name category format setting identifies electronic mail format settings that are common to the plurality of recipients.
4. The method of claim 1, wherein the electronic mail message is directed to a plurality of designated recipients, and wherein formatting content of the electronic mail message includes

identifying a set of compatible electronic mail format settings from among the electronic mail format settings of the designated recipients.

5. The method of claim 4, wherein if a set of compatible electronic mail format settings cannot be identified from among the electronic mail format settings of the designated recipients, a default set of electronic mail format settings is used to format the electronic mail message.
6. The method of claim 4, wherein the electronic mail format settings include at least one of closing information, stationery, or whether to use spell check.
7. The method of claim 1, wherein the electronic mail message is directed to a plurality of designated recipients, and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of designated recipients based on the one or more recipient profiles such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail format of a corresponding recipient profile.
8. The method of claim 7, wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message.
9. The method of claim 7, wherein the electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them.

10. The method of claim 1, wherein the electronic mail message is directed to more than one designated recipient, and wherein formatting the electronic mail message includes identifying a common set of electronic mail format settings for the more than one designated recipient, and wherein identifying a common set of electronic mail format settings includes:

identifying at least one of a group set of electronic mail content format settings, a domain name category set of electronic mail content format settings, or an individual set of electronic mail content format settings for each of the at least one designated recipient;

comparing each set of electronic mail content format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail content format settings; and

using the matching sets of electronic mail content format settings to reformat content of the electronic mail message.

11. A method of customizing an electronic mail message based on settings for an intended recipient, comprising:

receiving an electronic mail message;

retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient;

identifying at least one recipient of the electronic mail message;

identifying at least one electronic mail message format from the one or more recipient profiles for the at least one recipient; and

reformatting content of the electronic mail message based on the at least one electronic mail message format.

12. The method of claim 11, wherein the at least one recipient is categorized into a recipient group, and wherein the recipient group has electronic mail format settings that are common to all of the recipients in the recipient group.

13. The method of claim 11, wherein the at least one recipient is categorized into a domain name category, and wherein the domain name category has electronic mail format settings that are common to all of the recipients in the domain name category.

14. The method of claim 11, wherein the electronic mail message is directed to a plurality of recipients, and wherein reformatting content of the electronic mail message includes identifying a set of compatible electronic mail message format settings from among the electronic mail message format settings of the plurality of recipients.

15. The method of claim 14, wherein if a set of compatible electronic mail message format settings cannot be identified from among the electronic mail message format settings of the designated recipients, a default set of electronic mail message format settings is used to reformat content of the electronic mail message.

16. The method of claim 11, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check.

17. The method of claim 11, wherein the electronic mail message is directed to a plurality of recipients, and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of recipients based on the electronic mail message format settings for each of the plurality of recipients such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail message format settings of a corresponding one of the plurality of recipients.

18. The method of claim 17, wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message.

19. The method of claim 17, wherein the electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them.

20. The method of claim 11, wherein reformatting the electronic mail message includes identifying a common set of electronic mail message format settings for the at least one designated recipient, and wherein identifying a common set of electronic mail message format settings includes:

identifying at least one of a group set of electronic mail message content format settings, a domain name category set of electronic mail message content format settings, or an individual set of electronic mail message content format settings for each of the at least one recipient;

comparing each set of electronic mail message content format settings of each of the at least one recipient to each set of electronic mail message content format settings of each other recipient of the at least one recipient to identify matching sets of electronic mail message content

format settings; and

using the matching sets of electronic mail message content format settings to reformat content of the electronic mail message.

21. A method of customizing an electronic mail message based on settings for an intended recipient, comprising:

storing electronic mail format settings in recipient profiles for a plurality of possible recipients, the electronic mail format settings designating an electronic mail format for a recipient that is different from an electronic mail format of another recipient;

generating an electronic mail message for at least one designated recipient of the plurality of possible recipients; and

customizing content of the electronic mail message according to the electronic mail format settings for the recipient.

22. An apparatus for customizing an electronic mail message based on settings for an intended recipient, comprising:

an interface that receives an electronic mail message; and

an electronic mail message formatting device coupled to the interface that retrieves one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient, identifies at least one recipient of the electronic mail message, identifies at least one electronic mail message format from the one or more recipient profiles for the at least one recipient, and reformats content of the electronic mail message based on the at least one electronic mail message format.

23. The apparatus of claim 22, wherein the at least one recipient is categorized into a recipient group, and wherein the recipient group has electronic mail format settings that are common to all of the recipients in the recipient group.

24. The apparatus of claim 22, wherein the at least one recipient is categorized into a domain name category, and wherein the domain name category has electronic mail format settings that are common to all of the recipients in the domain name category.

25. The apparatus of claim 22, wherein the electronic mail message is directed to a plurality of recipients, and wherein the electronic mail message formatting device reformats content of the electronic mail message by identifying a set of compatible electronic mail message format settings from among the electronic mail message format settings of the plurality of recipients.

26. The apparatus of claim 25, wherein if a set of compatible electronic mail message format settings cannot be identified from among the electronic mail message format settings of the designated recipients, the electronic mail message formatting device uses a default set of electronic mail message format settings to reformat content of the electronic mail message.

27. The apparatus of claim 22, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check.

28. The apparatus of claim 22, wherein the electronic mail message is directed to a plurality of recipients, and wherein the electronic mail message formatting device replicates the electronic mail message into a different version of the electronic mail message for each of the plurality of recipients based on the electronic mail message format settings for each of the plurality of

recipients such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail message format settings of a corresponding one of the plurality of recipients.

29. The apparatus of claim 28, wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message.

30. The apparatus of claim 28, wherein the electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them.

31. The apparatus of claim 22, wherein the electronic mail message formatting device reformats content of the electronic mail message by identifying a common set of electronic mail message format settings for the at least one recipient, and wherein the electronic mail message formatting device identifies a common set of electronic mail message format settings by:

identifying at least one of a group set of electronic mail message content format settings, a domain name category set of electronic mail message content format settings, or an individual set of electronic mail message content format settings for each of the at least one recipient;

comparing each set of electronic mail message content format settings of each of the at least one recipient to each set of electronic mail message content format settings of each other recipient of the at least one recipient to identify matching sets of electronic mail message content format settings; and

using the matching sets of electronic mail message content format settings to reformat content of the electronic mail message.

32. A computer program product in a computer readable medium for customizing an electronic mail message based on settings for an intended recipient, comprising:

first instructions for receiving an electronic mail message;

second instructions for retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient;

third instructions for identifying at least one recipient of the electronic mail message;

fourth instructions for identifying at least one electronic mail message format from the one or more recipient profiles for the at least one recipient; and

fifth instructions for reformatting content of the electronic mail message based on the at least one electronic mail message format.

33. The computer program product of claim 32, wherein the at least one recipient is categorized into a recipient group, and wherein the recipient group has electronic mail format settings that are common to all of the recipients in the recipient group.

34. The computer program product of claim 32, wherein the at least one recipient is categorized into a domain name category, and wherein the domain name category has electronic mail format settings that are common to all of the recipients in the domain name category.

35. The computer program product of claim 32, wherein the electronic mail message is directed to a plurality of recipients, and wherein the fifth instructions for reformatting content of the electronic mail message include instructions for identifying a set of compatible electronic

mail message format settings from among the electronic mail message format settings of the plurality of recipients.

36. The computer program product of claim 35, wherein the fifth instructions further include instructions for using a default set of electronic mail message format settings to reformat content of the electronic mail message if a set of compatible electronic mail message format settings cannot be identified from among the electronic mail message format settings of the designated recipients.

37. The computer program product of claim 32, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check.

38. The computer program product of claim 32, wherein the electronic mail message is directed to a plurality of recipients, and wherein the fifth instructions for reformatting the electronic mail message includes instructions for replicating the electronic mail message into a different version of the electronic mail message for each of the plurality of recipients based on the electronic mail message format settings for each of the plurality of recipients such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail message format settings of a corresponding one of the plurality of recipients.

39. The computer program product of claim 38, wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message.

40. The computer program product of claim 38, wherein the electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them.

41. The computer program product of claim 32, wherein the fifth instructions for reformatting content the electronic mail message include instructions for identifying a common set of electronic mail message format settings for the at least one designated recipient, and wherein the instructions for identifying a common set of electronic mail message format settings include:

instructions for identifying at least one of a group set of electronic mail message content format settings, a domain name category set of electronic mail message content format settings, or an individual set of electronic mail message content format settings for each of the at least one recipient;

instructions for comparing each set of electronic mail message content format settings of each of the at least one recipient to each set of electronic mail message content format settings of each other recipient of the at least one recipient to identify matching sets of electronic mail message content format settings; and

instructions for using the matching sets of electronic mail message content format settings to reformat content of the electronic mail message.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.